

REMARKS

Status of Claims

This paper does not amend, cancel, or add any claims. Thus, claims 6-10, 12-19, and 25-30 are pending and under examination and claims 1-5 and 20-24 are withdrawn.

Rejections Under 35 U.S.C. 103(a)

Claims 6-10 and 12-19 stand rejected as obvious over Hill (U.S. Patent 5,476,184) in view of Hurwitz (U.S. Patent 5,620,069) and Zeddies (U.S. Patent 6,336,342) alone or in further combination with additional secondary references. Applicant respectfully traverses all rejections and submits that the basic combination of Hill, Hurwitz, and Zeddies fails to establish a *prima facie* case of obviousness. The deficiencies in the Hill/Hurwitz/Zeddies combination, as applied to independent claim 6, are not remedied by any of the cited secondary references.

In asserting this rejection, the Examiner alleges that Hill discloses a container system (a duffel bag) having a soft-sided outer shell which is at least partially collapsible by an unorganized reduction in volume and an inner frame. Office Action at page 2. The Examiner acknowledges that Hill does not teach an inner frame with rigid walls, but alleges that Zeddies discloses a container system having a collapsible inner frame with rigid walls. Office Action at page 3. The Examiner further alleges Hurwitz as providing a container system having a soft-sided outer shell comprising a waterproof material as an inner layer. Office Action at page 2. The Examiner concludes, therefore, that it is obvious to use the inner frame of Zeddies with the soft-sided outer shell of Hill, rendered waterproof according to Hurwitz, to arrive at Applicant's claimed invention. Office Action at page 2. Applicant respectfully traverses this rejection.

There is no motivation to combine Hill and Zeddies

As discussed in more detail below, there is no motivation to substitute the flexible wire struts of the Hill container system with the rigid inner frame of Zeddies. The key feature of the

Hill wire struts is its ability to be deformed under pressure (e.g., during transportation), but return to its original shape when the pressure is removed. Rigid inner frame of Zeddies is not capable of being reversibly deformed in this way and, therefore, its substitution for the wire struts of Hill vitiates the key feature of the Hill invention. Thus, the artisan has no motivation to, and is in fact dissuaded from, making the substitution alleged by the Examiner.

Hill provides a soft-sided duffel bag having a removable framing device consisting of wire struts. Hill identifies that “[a] drawback of all duffel bags... is the fact that the soft sides of the bag continually cave in when a person is trying to pack articles into the bag or remove articles from the bag.” Hill at col. 1, ll. 19-22. To remedy this problem associated with soft-sided duffel bags, Hill states:

It is a particular objective of the present invention to effectively solve the problem of collapsing soft side walls of a duffel bag by providing means for supporting the side walls in position when desired, while at the same time retaining the ability of the duffel bag to be deformed so as to be squeezed into irregular shaped areas.

Hill at col. 1, ll. 32-37 (emphasis added).

To solve this problem, Hill provides a framing device that is both supportive of the side walls for packing and unpacking, and deformable when the bag is in use for the transportation of contents (i.e., being squeezed into irregular shaped areas). The Hill framing device consists of deformable struts. Specifically, Hill states:

The struts of the invention are formed of spring tempered wire so that when in the upright supporting position, they can be readily deformed and in fact can be drastically distorted and still automatically return to their original shape and position.

Hill at col. 2., ll. 1-5 (emphasis added).

The advantage that this strut system provides is that

[t]his enables the duffel bag to be squeezed into a restrictive space such as when a large amount of luggage is placed into the trunk of a car, and yet when the

pressure which causes the struts to be distorted is removed, the duffel bag will automatically be restored to its original shape and the soft sides of the bag will be supported for unpacking.

Hill at col. 2., ll. 5-10 (emphasis added).

Thus, the wire strut frame of Hill is characterized by two key features: (i) deformable under pressure (e.g., during transportation), and (ii) supportive of the soft-sided outer shell when not under pressure (e.g., during packing and unpacking).

The skilled artisan is not motivated to use the Zeddies frame, or any frame having rigid walls, with the duffel bag of Hill. The use of a rigid inner frame, as alleged by the Examiner, vitiates one critical feature of the Hill container system. A rigid inner frame is not deformable under pressure and therefore would be incapable of being “squeezed into irregular shaped areas.” Thus, the artisan would not make the substitution of the Zeddies inner frame for the Hill struts, as alleged by the Examiner. In fact, based on the inner frame requirements described by Hill, Hill teaches away from the use of a rigid inner frame with a soft-sided outer shell. Accordingly, the combination of Hill and Zeddies fails to establish a *prima facie* case of obviousness.

Hurwitz (U.S. Patent 5,620,069)

As noted above, the Examiner relies on Hurwitz merely for a teaching that the soft-sided outer shell may be constructed having a waterproof material as an inner layer. Office Action at page 2. This does not remedy the deficiency in the combination of Hill and Zeddies discussed above because it does not motivate the substitution of the rigid inner frame of Zeddies for the deformable wire struts of Hill. Thus, the rejection of claims 6 and 12-14 should be withdrawn.

Tattam (U.S. Patent 6,609,628)

Claims 7-8 stand rejected as obvious over Hill in view of Zeddies and Hurwitz, and in further view of Tattam. The Examiner alleges that Tattam discloses a collapsible container that may be used for transportation of organs. Office Action at page 3. Tattam does not remedy the deficiencies in the combination of Hill and Zeddies, as discussed above, because it does not

motivate the substitution of the rigid inner frame of Zeddies for the deformable wire struts of Hill. Furthermore, the Examiner fails to allege why the artisan would be motivated to transport organs in the container system created by the Hill/Hurwitz/Zeddies combination. Hill and Hurwitz provide container systems for personal luggage and Zeddies provides a container system adapted for use with a grocery shopping cart (see, for example, Zeddies at col. 3, ll. 20-23). Nowhere in any of the primary references is it suggested that these container systems are suitable to be adapted, or should be adapted, for transporting biohazardous materials such as organs. Furthermore, nothing in Tattam directs the artisan to modify the container system in the style of the Hill/Hurwitz/Zeddies combination, as alleged by the Examiner. Accordingly, for each of these reasons, this rejection is traversed and should be withdrawn.

Boyd-Moss et al (U.S. Patent 6,609,628)

Claim 9 stands rejected as obvious over Hill in view of Zeddies and Hurwitz, and in further view of Boyd-Moss et al. The Examiner alleges that Boyd-Moss et al. discloses a container that conforms to IATA 602 requirements. Office Action at pages 3-4. Boyd-Moss et al. does not remedy the deficiencies in the combination of Hill and Zeddies, as discussed above, because it does not motivate the substitution of the rigid inner frame of Zeddies for the deformable wire struts of Hill. Furthermore, the Examiner fails to allege how or why the artisan would conform the container system of the Hill/Hurwitz/Zeddies combination to IATA 602 requirements in view of Boyd-Moss et al. As noted above, Hill and Hurwitz provide container systems for personal luggage and Zeddies provides a container system adapted for use with a grocery shopping cart (see, for example, Zeddies at col. 3, ll. 20-23). Boyd-Moss et al. provides "a crush resistant tube" suitable to be placed in a protective envelope. See, for example, Boyd-Moss et al. at Abstract. The Examiner has put forth no credible rationale or method for adapting the structural features of the Boyd-Moss et al. sample mailer that comply with IATA 602 requirements to a large multi-component container systems useful for transporting organs. Accordingly, for each of these reasons, this rejection is traversed and should be withdrawn.

Rejections Over the Further Combination of Kalal, Mogil, Travis, and/or McHutchison

Claims 10, 16-19, and 25 stand rejected as obvious over Hill in view of Zeddies and Hurwitz, and in further view of Kalal (U.S. Patent Publication 2003/0106895), Mogil (U.S. Patent 6,582,124), Travis (U.S. Patent 4,585,159), and/or McHutchison (WO 02/18210). . None of these prior art references, alone or in combination, remedy the deficiencies in the combination of Hill and Zeddies, as discussed above, because none of the references motivate the substitution of the rigid inner frame of Zeddies for the deformable wire struts of Hill. Accordingly, these rejections are traversed and should be withdrawn.

Rejection For Obviousness-type Double Patenting

Claims 6-10, 12, 14-18, 26-27, and 29 stand provisionally rejected over various claims of co-pending U.S. Application No. 12/324,666 for obviousness-type double patenting. Applicants respectfully traverse this rejection.

The instant application was subject to restriction which was orally elected and acknowledged in the Office Action of November 16, 2005. That Restriction Requirement restricted the then-pending claims into two groups: methods for using a container (Group I) and the container (Group II). Group II was elected and is currently under examination. By restricting the instant case, the Office acknowledges that the container and the methods for using the container represent two independent and distinct inventions.

U.S. Application No. 12/324,666 is a continuation of the instant application and the pending claims are directed to methods for using a container system, in which the container system generally conforms to the container system of the instant claims. Thus, this continuation application is effectively claiming the subject matter of Group I separated by restriction from the instant invention.

35 U.S.C. § 121 prohibits the Office from using the related application as a basis to deny patentability if that application resulted from a restriction requirement. Accordingly, this provisional rejection is improper and should be withdrawn.

Applicant notes that this provisional obviousness-type double patenting rejection is the sole rejection outstanding against claims 26-30. In the event that the Examiner does not withdraw this rejection, Applicants request that the rejection be held in abeyance until claims 6-10, 12-19, and 25 are canceled or otherwise found to be allowable which will result in the instant rejection being the only outstanding rejection. If necessary, a terminal disclaimer can be filed at that time.

CONCLUSION

Applicant respectfully submits that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the telephone number listed below so that they may be resolved without the need for a written action.

The Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of

papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 01/27/10

By Barry Wilson

FOLEY & LARDNER LLP

Customer Number: 30542

Telephone: (858) 847-6722

Facsimile: (858) 792-6773

Richard J. Warburg, Reg. No. 32,327

By Barry Wilson, Reg. No. 39,431

Attorney for Applicant